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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/728,302

Applicant(s)

TAGG, JAMES S.

Examiner

Paul H Kang

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-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner Sajid Yussuf is no longer assigned to the present patent application. This application is now assigned to Examiner Paul H. Kang. In examining this patent application, full faith and credit has been given to the search and action of the previous examiner. See MPEP § 719.05.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. *Claims 1, 3-9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potts et al. (US Patent No. 6,026,432 and Potts hereinafter) in view of Dowling et al. (US Patent No. 6,819,339 and Dowling hereinafter).*

4. As per claim(s) 1, 8, 9, 16-17, Potts discloses the invention substantially as claimed. Potts teaches providing a website (i.e., Hyperlink) having a web page (i.e., HTML) accessible via a browser program, the browser program having browser print controls for initiating processing of print jobs, (See Column 3 Lines 50-67 & Column 4 Lines 1-4); providing printable content that is associated with the website but not displayed on the web page (See Column 4 Lines 50-67);

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and in response to user activation of the print activator, printing the printable content at a printer, (See Column 5 Lines 1-25).

However, Potts does not explicitly teach providing a print activator on the web page, where activation of the print activator enables a user to initiate printing without having to operate the browser print controls. In the same field of endeavor, Dowling teaches a system and method for printing documents over the internet, wherein a print activator is provided to enable a user to initiate printing without operating the browser print controls (Dowling, col. 2, lines 22-60 and col. 6, line 53 – col. 8, line 10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated providing a print activator on a web page, as taught by Dowling, into the printing system of Potts for the purpose of enabling flexibility in printing options customizable to a specific web page.

5. As per claims 3 and 11, Potts-Dowling teach the claimed invention as described in claims 1-2 & 9-10 above and furthermore discloses the print activator takes the form of a hyperlink that identifies the printable content (See Potts, Column 4 Lines 30-67 & Figure 4; and Dowling, col. 6, line 53 – col. 8, line 10).

6. As per claims 4 and 12, Potts-Dowling teach the claimed invention as described in claim(s) 1-3 & 9-11 above and furthermore discloses the print button activates the print processing functions provided on the computer running the browser program (See Potts, Column 4 Lines 35-49 and Dowling, col. 6, line 53 – col. 8, line 10).

7. As per claims 5 and 13, Potts-Dowling teach the claimed invention as described in claim(s) 1-4 & 9-12 above and furthermore discloses activation of the print button causes printing to be performed by bypassing the print features provided on the browser program, (See Potts, Column 4 Lines 62-67 & Column 5 Lines 1-25, and Dowling, col. 2, lines 22-60 and col. 6, line 53 – col. 8, line 10).

8. As per claims 6 and 14, Potts-Dowling teach the claimed invention as described in claim(s) 1-6 & 9-13 above and furthermore discloses where the print button causes the printable content to downloaded, (i.e., printed) directly to the printer, (See Potts, Column 5 Lines 1-34 and Dowling, col. 6, line 53 – col. 8, line 10).

9. As per claims 7 and 15, Potts-Dowling teach the claimed invention as described in claim(s) 1-7 & 9-14 above and furthermore discloses the printable content is separated into a plurality of sections (i.e., directory/sub-directory) that are downloaded individually (i.e., printed) to the printer, (See Potts, Column 6 Lines 9-31 and Dowling, col. 2, lines 22-60 and col. 6, line 53 – col. 8, line 10).

10. ***Claims 2, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potts-Dowling as applied above, and further in view of Nowers et al., US Pat. App. No. 2003/0033205 A1.***

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11. As per claims 2 and 10, Potts-Dowling teaches the invention substantially as claimed. However, Potts-Dowling do not explicitly teach the system or method wherein the printable content is a catalog featuring consumer products and/or services. In the same field of endeavor, Nowers teaches a system and method for providing online catalogs downloads (See Nowers, paragraphs 0162-0167).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated catalogs, as taught by Nowers, into the web system of Potts-Dowling for the purpose of enabling on line commerce.

12. Claim 18 is a combination of claims 1 and 2; therefore, claim 18 is rejected under the same rationale.

Supplemental Rejections - Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

14. Claims 1, 3-9 and 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Dowling et al. (US Patent No. 6,819,339 and Dowling hereinafter).

15. As per claims 1, 8, 9 and 16-18, Dowling discloses providing a website (i.e., Hyperlink) having a web page (i.e., HTML) accessible via a browser program, the browser program having browser print controls for initiating processing of print jobs (See Dowling, col. 6, line 53 – col. 8, line 10);

providing printable content that is associated with the website but not displayed on the web page (Dowling, col. 6, line 53 – col. 8, line 10); where the printable content is not formatted for display by the web browser, but rather is specially formatted for output in printed hard copy form (Dowling, col. 6, line 53 – col. 8, line 10 and col. 10, lines 14-35);

providing a print activator on the web page, where activation of the print activator enables a user to initiate printing without having to operate the browser print controls, (Dowling, col. 2, lines 22-60 and col. 6, line 53 – col. 8, line 10); and

in response to user activation of the print activator, initiating printing of the printable content at a printer independent of any operation of the browser print controls (Dowling, col. 2, lines 22-60 and col. 6, line 53 – col. 8, line 10).

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16. As per claims 3 and 11, Dowling teaches the claimed invention as described in claims 1-2 & 9-10 above and furthermore discloses the print activator takes the form of a hyperlink that identifies the printable content (See Dowling, col. 6, line 53 – col. 8, line 10).

17. As per claims 4 and 12, Dowling teaches the claimed invention as described in claim(s) 1-3 & 9-11 above and furthermore discloses the print button activates the print processing functions provided on the computer running the browser program (See Dowling, col. 6, line 53 – col. 8, line 10).

18. As per claims 5 and 13, Dowling teaches the claimed invention as described in claim(s) 1-4 & 9-12 above and furthermore discloses activation of the print button causes printing to be performed by bypassing the print features provided on the browser program (Dowling, col. 2, lines 22-60 and col. 6, line 53 – col. 8, line 10).

19. As per claims 6 and 14, Dowling teaches each the claimed invention as described in claim(s) 1-6 & 9-13 above and furthermore discloses where the print button causes the printable content to be downloaded, (i.e., printed) directly to the printer (Dowling, col. 6, line 53 – col. 8, line 10).

20. As per claims 7 and 15, Dowling teaches the claimed invention as described in claim(s) 1-7 & 9-14 above and furthermore discloses the printable content is separated into a plurality of sections that are downloaded individually to the printer (Dowling, col. 2, lines 22-60 and col. 6,

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line 53 – col. 8, line 10).

21. ***Claims 2, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowling as applied above, and further in view of Nowers et al., US Pat. App. No. 2003/0033205 A1.***

22. As per claims 2 and 10, Dowling teaches the invention substantially as claimed. However, Dowling does not explicitly teach the system or method wherein the printable content is a catalog featuring consumer products and/or services. In the same field of endeavor, Nowers teaches a system and method for providing online catalogs downloads (See Nowers, paragraphs 0162-0167).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated catalogs, as taught by Nowers, into the web system of Dowling for the purpose of enabling on line commerce.

23. Claim 18 is a combination of claims 1 and 2; therefore, claim 18 is rejected under the same rationale.

24. ***Claims 1, 3-9 and 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwata (US Patent No. 6,778,289 and Iwata hereinafter).***

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25. As per claims 1, 8, 9 and 16-18, Iwata discloses providing a website (i.e., Hyperlink) having a web page (i.e., HTML) accessible via a browser program, the browser program having browser print controls for initiating processing of print jobs (See Iwata, col. 1, line 13 – col. 4, line 32);

providing printable content that is associated with the website but not displayed on the web page, where the printable content is not formatted for display by the web browser, but rather is specially formatted for output in printed hard copy form (See Iwata, col. 7, line 19 – col. 8, line 67 and col. 10, lines 25-45);

providing a print activator on the web page, where activation of the print activator enables a user to initiate printing without having to operate the browser print controls (See Iwata, Fig. 14 and col. 7, line 19 – col. 8, line 17); and

in response to user activation of the print activator, initiating printing of the printable content at a printer independent of any operation of the browser print controls (See Iwata, col. 5, line 39 – col. 6, line 17 and col. 7, line 19 – col. 8, line 17).

26. As per claims 3 and 11, Iwata teaches the claimed invention as described in claims 1-2 & 9-10 above and furthermore discloses the print activator takes the form of a hyperlink that identifies the printable content (See Iwata, Fig. 14 and col. 7, line 19 – col. 8, line 17).

27. As per claims 4 and 12, Iwata teaches the claimed invention as described in claim(s) 1-3 & 9-11 above and furthermore discloses the print button activates the print processing functions

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provided on the computer running the browser program (See Iwata, Fig. 14 and col. 7, line 19 – col. 8, line 17).

28. As per claims 5 and 13, Iwata teaches the claimed invention as described in claim(s) 1-4 & 9-12 above and furthermore discloses activation of the print button causes printing to be performed by bypassing the print features provided on the browser program, (See Iwata, Fig. 14 and col. 7, line 19 – col. 8, line 17).

29. As per claims 6 and 14, Iwata teaches each the claimed invention as described in claim(s) 1-6 & 9-13 above and furthermore discloses where the print button causes the printable content to downloaded, (i.e., printed) directly to the printer, (See Iwata, Fig. 14 and col. 7, line 19 – col. 8, line 17).

30. As per claims 7 and 15, Iwata teaches the claimed invention as described in claim(s) 1-7 & 9-14 above and furthermore discloses the printable content is separated into a plurality of sections that are downloaded individually to the printer, (See Iwata, Fig. 14 and col. 7, line 19 – col. 8, line 17).

31. ***Claims 2, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata as applied above, and further in view of Stromberg., US Pat. App. No. 2002/0007322 A1.***

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32. As per claims 2 and 10, Iwata teaches the invention substantially as claimed. However, Iwata does not explicitly teach the system or method wherein the printable content is a catalog featuring consumer products and/or services. In the same field of endeavor, Stromberg teaches a system and method for providing online catalogs downloads (See Stromberg, paragraphs 0007-0008).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated catalogs, as taught by Stromberg, into the web system of Iwata for the purpose of enabling on line commerce.

33. Claim 18 is a combination of claims 1 and 2; therefore, claim 18 is rejected under the same rationale.

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection. In part, applicants argued in substance that:

- a. The prior art of record fails to teach the claimed invention including a print activator on the web page and a printable content being a catalog.

As to point a), the new grounds of rejection teaches these and other features.

b. Applicants' declaration under 37 CFR 1.131, demonstrating conception and diligent reduction to practice by applicant from a time preceding the effective date of Goodwin et al. ...thus removes Goodwin et al. as prior art.

As to point b), the evidence submitted is **insufficient** to establish diligence from a date prior to the date of reduction to practice of the Goodwin reference to either a constructive reduction to practice or an actual reduction to practice. The declaration makes a general assertion that the inventor "diligently worked toward reducing my invention to practice, as demonstrated by the HP Invention Disclosure, dated May 9, 2000," without a statement of facts demonstrating the correctness of this conclusion. "General statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice 'amounts essentially to mere pleading, unsupported by proof or a showing of facts' and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit 'asserts that facts exist but does not tell what they are or when they occurred.')." See MPEP 715.07.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAUL H. KANG
PRIMARY PATENT EXAMINER